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| EXAMINER |
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CERVETTI, DAVID GARCIA

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| ART UNIT | PAPER NUMBER |
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2136

| SHORTENED STATUTORY PERIOD OF RESPONSE | NOTIFICATION DATE | DELIVERY MODE |
|--|-------------------|---------------|
| 3 MONTHS | 02/01/2007 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary

Application No.

09/915,271

Applicant(s)

KEECH, WINSTON DONALD

Examiner

David G. Cervetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/11/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments filed November 20, 2006, have been fully considered but they are not persuasive.
2. Claims 1-23 and 32 are pending and have been examined. Claims 24-31 have been canceled previously.

Response to Amendment

3. The objection to the abstract is withdrawn.
4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., generated by the user utilizing relatively simplistic algorithms) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
5. Walker et al. (US Patent 6,163,771) teaches an electronic device in electronic communication with said host computer for administering said transaction by receiving and displaying said pseudo-random security string and for receiving a user generated transaction input code, wherein said user generated transaction input code is determined by the user applying said user code to said pseudo-random security string displayed on said at least one electronic device, wherein said user generated transaction input code is sent to said host computer (col. 8, lines 9-36, col. 11, lines 20-62). Walker teaches a user device displaying the string, a merchant receiving the one-time use card number, and transmitting it to a host (central processor) (col. 8, lines 10-

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67, col. 9, lines 1-10). Walker further teaches a user authenticating access to the card to receive/read card number, presenting card number to a merchant, and a merchant providing it to a central processor for authentication (cols. 10-11). Walker further discloses the “wherein said user generated transaction input code is determined by the user applying said user code to said pseudo-random security string displayed on said at least one electronic device” (nonce relates to the check code employed by conventional credit card numbers – col. 7, lines 50-67). **Applicant’s arguments are not persuasive.**

6. The following prior art was/is used in this rejection: Kawana (US Patent Number: 4,697,072); Goldfine et al. (US Patent Number: 5,343,529, hereinafter Goldfine), Bickham et al. (US Patent Number: 5,530,438, hereinafter Bickham), Lee (US Patent Number: 6,748,367), and Wilder (US Patent Number 5,408,417), Walker et al. (US Patent 6,163,771, hereinafter Walker), Corder et al. (US Patent 5,936,221, hereinafter Corder).

Double Patenting

7. Claims 1-23 and 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of Patent 7,043,635. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully claimed in the referenced patent.

8. This is a provisional obviousness-type double patenting rejection because the conflicting pending claims have not in fact been patented.

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9. The subject matter claimed in the instant application is fully claimed in the referenced patent and is covered by the patent granted since the referenced patent and the instant application are claiming common subject matter, as follows:

- the instant application claims an identity verification secure transaction system comprising: a host computer for storing a user code associated with a user, for supplying a pseudo-random security string for a transaction, wherein said host computer determines a one time transaction code by applying said user code to said pseudo-random security string; and at least one electronic device in electronic communication with said host computer for administering said transaction by receiving and displaying said pseudo-random security string and for receiving a user generated transaction input code, wherein said user generated transaction input code is determined by the user applying said user code to said pseudo-random security string displayed on said at least one electronic device, wherein said user generated transaction input code is sent to said host computer; and
- wherein said host computer verifies that said user generated input code matches said one time transaction code;
- the copending application claims a coded identification system, the system comprising an electronic computer, a specific electronic communications device that is operable to be in communication with the electronic computer, and at least one electronic communications device

that is operable to be in communication with the electronic computer, wherein the electronic computer includes data relating to the specific electronic communications device, including a permanent identification code, a mask code and an identification code enabling electronic communication between the electronic computer and the specific electronic communications device, and wherein the permanent identification code is input to the at least one electronic communications device and transmitted to the electronic computer, the electronic computer generates a pseudo-random string and transmits this to the specific electronic communications device, the mask code is applied to the pseudo-random string so as to generate a volatile identification code in accordance with predetermined rules, the volatile identification code is transmitted back to the electronic computer by the specific electronic communications device or the at least one electronic communications device, the electronic computer checks the volatile identification code transmitted thereto against a volatile identification code obtained by applying the mask code to the pseudo-random string in accordance with the predetermined rules, and in which a positive identification is made when the volatile identification codes are found to match by the electronic computer, wherein the pseudo-random string comprises a first array of characters; each character having a given numerical position in the first array (first, second, third etc.), and wherein the mask code comprises a

second array of numbers, each number having a given numerical position in the second array (first, second, third etc.), the predetermined rules for applying the mask code to the pseudo-random string so as to generate the volatile identification code being sequentially to select numerical positions in the first array on the basis of the numbers in the second array, taken in positional order, and to return the characters thereby selected from the first array in sequence so as to form a third array, this third array forming the volatile identification code.

10. Claims 1-23 and 32 of the instant application are envisioned by Patent 7,043,635's claims 1-23 in that claims 1-23 of the copending application contain all the limitations of claims 1-23 and 32 of the instant application. Claims 1-23 and 32 of the instant application therefore are not patently distinct from the patent claims and as such are unpatentable for obvious-type double patenting.

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker, and further in view of Corder.

Regarding claim 1, Walker teaches an identity verification secure transaction system (**abstract**) comprising: a host computer for storing a user code associated with a user, for supplying a pseudo-random security string for a transaction, wherein said host computer determines a one time transaction code by applying said user code to

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said pseudo-random security string (**column 11, lines 20-62**); and at least one electronic device in electronic communication with said host computer for administering said transaction by receiving and displaying said pseudo-random security string and for receiving a user generated transaction input code, wherein said user generated transaction input code is determined by the user applying said user code to said pseudo-random security string displayed on said at least one electronic device, wherein said user generated transaction input code is sent to said host computer (**column 11, lines 20-62**); and wherein said host computer verifies that said user generated input code matches said one time transaction code (**column 6, lines 1-62**). Walker does not expressly disclose the electronic device receiving the code. However, Corder teaches a host sending and a device receiving information (column 4, lines 9-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to request/receive information at an electronic device from a host computer. One of ordinary skill in the art would have been motivated to do so to provide fund transfers (Corder, column 4, lines 26-53).

Regarding claim 15, Walker teaches a method of verifying an identity for conducting secure transactions comprising the steps of (**abstract**): storing information about a user pin associated with a host computer; generating a pseudo-random security string by said host computer; determining a transaction code by applying said user pin to said pseudo-random security string (**column 11, lines 20-62**); displaying said pseudo-random security string on said at least one electronic device for use by said user (**column 11, lines 20-62**); receiving from the user said user generated transaction

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input code on said at least one electronic device (**column 11, lines 20-62**), wherein said user generated transaction input code is determined by the user applying said user code to said pseudo-random security string; wherein said at least one electronic device transmits said user generated transaction input code to said host computer (**column 11, lines 20-62**); and said host computer determines whether said transaction code and said user generated transaction input code match (**column 6, lines 1-62**). Walker does not expressly disclose transmitting said pseudo-random security string to at least one electronic device. However, Corder teaches a host sending and a device receiving information (column 4, lines 9-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to transmit the generated string to at least one electronic device. One of ordinary skill in the art would have been motivated to do so to provide fund transfers (Corder, column 4, lines 26-53).

Regarding claim 2, the combination of Walker and Corder teaches wherein said at least one electronic device is an Electronic Funds Transfer Point of Sale (EFT/POS) device (Walker, fig 3B, credit card processor, Corder, column 1, lines 33-67).

Regarding claim 3, the combination of Walker and Corder teaches wherein said at least one electronic device is comprised of an Electronic Funds Transfer Point of Sale (EFT/POS) device for administering said transaction and receiving said user generated transaction input code and a wireless device associated with said user (Walker, fig 3B, credit card processor, column 11, lines 20-62) for receiving and displaying said pseudo-random security string (Walker, column 4, lines 9-67, column 11, lines 20-62).

Regarding claim 4, the combination of Walker and Corder teaches where said one time transaction code is received and displayed by said wireless device instead of said pseudo-random security string (Walker, column 11, lines 20-62).

Regarding claim 5, the combination of Walker and Corder teaches wherein said at least one electronic device is a wireless device associated with said user (Corder, column 4, lines 26-53).

Regarding claim 6, the combination of Walker and Corder does not expressly teach wherein said one time transaction code is sent to said wireless device instead of said pseudo-random security string. However, Walker teaches generating a "one-time use card number" (column 11, lines 20-62) and generating the code. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to transmit anything other than the card number as long as it served as a unique identifier for a transaction (Corder, columns 4-5).

Regarding claim 7, the combination of Walker and Corder teaches wherein said at least one electronic device is comprised of: a user computer, in electronic communication with said host computer, for receiving (Corder, column 4, lines 9-67) and displaying said pseudo-random security string and receiving said user generated transaction input code (Walker, column 11, lines 20-62); and a merchant computer, in electronic communication with said user computer and said host computer, for administering said transaction, wherein one of said at least one electronic device relays said user generated transaction input code to said host computer for user identity verification (Walker, columns 10-11).

Regarding claim 8, the combination of Walker and Corder teaches wherein said user computer and said merchant computer communicate via the Internet (Corder, column 4, lines 9-67).

Regarding claim 9, the combination of Walker and Corder teaches wherein said one time transaction code is received and displayed by said user computer instead of said pseudo-random security string (Walker, column 11, lines 20-62).

Regarding claim 10, the combination of Walker and Corder teaches wherein said at least one electronic device is comprised of: a wireless device associated with said user for receiving and displaying said pseudo-random security string (Walker, column 11, lines 20-62), a user computer, in electronic communication with said host computer, for receiving said user generated transaction input code (Corder, column 4, lines 9-67); and a merchant computer, in electronic communication with said user computer and said host computer, for administering said transaction, wherein one of said at least one electronic device relays said user generated transaction input code to said host computer for user identity verification (Walker, columns 10-11).

Regarding claim 11, the combination of Walker and Corder teaches wherein said one time transaction code is received and displayed by said wireless device instead of said pseudo-random security string (Walker, column 11, lines 20-62).

Regarding claim 12, the combination of Walker and Corder teaches wherein said host computer upon verification allows completion of said transaction (Walker, column 11, lines 45-67, column 12, lines 1-39).

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Regarding claim 13, the combination of Walker and Corder teaches wherein said host computer upon verification allows access to a database (Walker, column 11, lines 45-67, column 12, lines 1-39).

Regarding claim 14, the combination of Walker and Corder teaches wherein said host computer upon verification allows access to account information (Walker, column 11, lines 45-67, column 12, lines 1-39).

Regarding claim 16, the combination of Walker and Corder teaches completing a transaction when said transaction code and said user generated transaction input code match (Walker, column 11, lines 45-67, column 12, lines 1-39).

Regarding claim 17, the combination of Walker and Corder teaches providing access to a database when said transaction code and said user generated transaction input code match (Walker, column 11, lines 45-67, column 12, lines 1-39).

Regarding claim 18, the combination of Walker and Corder teaches providing access to account information when said transaction code and said user generated transaction input code match (Walker, column 11, lines 45-67, column 12, lines 1-39).

Regarding claim 19, the combination of Walker and Corder teaches transmitting (Corder, column 4, lines 9-67) and displaying said pseudo-random security string on an Electronic Funds Transfer Point of Sale (EFT/POS) device (Walker, fig 3B, credit card processor, column 11, lines 20-62).

Regarding claims 20 and 21, the combination of Walker and Corder teaches transmitting (Corder, column 4, lines 9-67) and displaying said pseudo-random security string on a wireless device associated with said user / user computer wherein said user

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computer is in electronic communication with said host computer (Walker, column 11, lines 20-62).

Regarding claim 22, the combination of Walker and Corder teaches communicating between the said host computer and said user computer via the Internet (Corder, column 4, lines 9-67).

Regarding claim 23, the combination of Walker and Corder teaches transmitting (Corder, column 4, lines 9-67) and display said transaction code to said at least one electronic device (Corder, column 4, lines 9-67).

13. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and Corder, and further in view of Wilder.

Regarding claim 32, the combination of Walker and Corder does not expressly disclose wherein said user interaction input code is entered through any area of a touch sensitive display. However, Wilder teaches using a touch sensitive display to enter a code (column 2, lines 41-68, column 3, lines 1-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a touch sensitive screen with the system of Walker and Corder. One of ordinary skill in the art would have been motivated to do so because using a touch sensitive screen to provide a friendly interface to customers (Wilder, column 2, lines 1-40).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571) 272-

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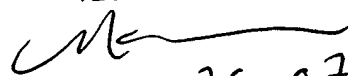
5861. The examiner can normally be reached on Monday-Friday 7:00 am - 5:00 pm, off on Wednesday.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DGC

NASSER MOAZZAMI
SUPERVISORY PATENT EXAMINER
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1/26/07